

## **REMARKS**

### ***Amendments***

The Office Action of April 18, 2006 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested.

Claim 1 has been amended to require that the steps set forth therein occur in the sequence indicated. Applicants do not believe new matter has been added as a result of the amendments. Claims 1 and 14 have also been amended to clarify the nature of the grinding and the results thereof. Support for the amendments to claims 1 and 14, for example, the grinding and polishing steps, is found at pp. 11 – 12 of the Specification and as depicted in at least FIG. 1. Claim 11 has also been amended to correct a typographical error noted by the Examiner.

### ***Election/Restriction***

Restriction was required to what was alleged to be one of two inventions, either Invention I (claims 1-13) or Invention II (claims 14-19). Inventions I and II were indicated as being related as a process of making and product made. Applicants respectfully confirm the provisional election of March 14, 2006 and hereby elect claims 1 – 13 (Invention I) with traverse.

Applicants respectfully submit that the restriction requirement is improper and fails to set forth an adequate basis for the restriction. As the basis for the restriction the Examiner states that “the product as claimed can be made by another and materially different process such as altering an in-situ concrete floor to have a terrazzo like appearance.” Applicants respectfully submit that this merely a statement of conclusion, and that the Examiner has not met the burden of showing that the product claimed can be made by another materially different process. The requirement for restriction should be withdrawn. In view of Applicants traversal of the restriction requirement, no claims to the non-elected invention have been cancelled.

In the event the restriction is maintained, Applicants respectfully request that the Examiner set forth the particular reason(s) relied on for holding that the inventions, as claimed in I and II are either independent or distinct. The reasons upon which the

conclusion is based should be given, and Applicants request, in the event that the restriction requirement is maintained, that the Examiner document the alternative process alleged.

Claim 11 was objected to as not including a period at the end. As noted above, claim 11 has been amended to include a period and the objection is now believed to have been fully addressed by Applicants. Acknowledgement of the withdrawal of the rejection is requested in a subsequent communication.

### ***Rejections***

Turning now to the rejections set forth in the office action, claims 1-5 and 7-10 were rejected under 35 U.S.C. 102(b) as being anticipated by Shaw et al., U.S. Patent 6,033,146 (Shaw). Claims 1, 3, 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Paoli, U.S. Patent 2,835,996 (Paoli). Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Jones et al., U.S. Patent 6,454,632 (Jones).

### ***35 U.S.C. 102(b)***

Claims 1-5 and 7-10 were rejected under 35 U.S.C. 102(b) as being anticipated by Shaw. Shaw discloses a surface-seeded, exposed particulate concrete. Relative to surface seeding/exposure, Shaw teaches at col. 1, lines 22-48, that the exposure of aggregate leads to surface roughness when large aggregate is used and precludes use of the technique in flooring. Applicants understand such teaching to indicate that the aggregate exposure taught by Shaw purposely does not intentionally remove the aggregate material itself, but exposes the surface of such material. While Shaw does suggest that sandblasting, acid etching or grinding and polishing may also be used to create texture variations (col. 4, lines 63-65), Applicants understand these treatments to be selective treatments to provide texture variations that would appear to teach away from the intent of the present invention – to permit creation of a smooth surface suitable for a floor.

In order to further clarify the present application, independent claim 1 has been amended to specifically recite the steps, in order, of preparing and forming the region to

be poured, pouring concrete, floating the concrete, allowing the concrete to cure to a semi-stiff state, finishing the exposed upper surface of the concrete to a generally planar surface, disbursing decorative aggregate over only the surface, and integrating the aggregate into the upper surface of the semi-stiff concrete. These steps are then followed by partially curing the concrete with the integrated aggregate, grinding the upper surface of the partially cured concrete having the integrated aggregate therein, including partially removing some integrated aggregate material at least until the aggregate is exposed uniformly over the top of the concrete, fully curing the concrete with the integrated aggregate, and polishing the upper surface with the integrated aggregate to provide a generally planar and smooth surface on the monolithic concrete floor. Applicants urge that although some steps of the recited method of claim 1 may be similar to the steps taught by Shaw, several steps are not taught by Shaw nor is the presently recited order of the steps believed to be disclosed by Shaw.

Furthermore, Shaw fails to teach partially curing the concrete, followed by grinding the upper surface of the partially cured concrete, including partially removing some integrated aggregate material at least until the aggregate is exposed uniformly over the top of the concrete, and then fully curing the concrete with the integrated aggregate before polishing the upper surface with the integrated aggregate to provide a generally planar and smooth surface. In light of the failure of Shaw to teach the recited steps, or the order set forth, Applicants respectfully contend that amended claim 1 is not anticipated by Shaw. As for the remaining dependent claims, Applicants respectfully submit that these claims are unanticipated for the reasons set forth with respect to claim 1.

Relative to claims 8 – 10, Applicants wish to note that the Examiner appears to have relied upon Applicants disclosure for a teaching that Applicants do not believe is present. In particular, published para. 0042 includes the disclosure of a chemical agent that may be sprayed, such as a curing compound, that absorbs into the top layer of the concrete to assist the surface to cure, whereas para. 0049 suggests the use of a concrete sealer/hardener that may be applied to provide a highly-polished surface appearance. Applicants are not aware of any acknowledgement that “silicate sealers inherently function as both a hardening and sealing compound” as has been urged by the Examiner.

Claims 1, 3, 4 and 7 were rejected under 35 U.S.C. 102(b) as being anticipated by Paoli. Paoli is directed to terrazzo construction by inserting pre-formed terrazzo “splatters” 12 into a semi-plastic slab that has been prepared a mold using terrazzo layer (col. 1, lines 59-65). The mold containing the splatters and terrazzo is then pressurized and cured before being ground smooth (col. 2, lines 11-19). The Examiner urges that it is inherent that a region for pouring a monolithic floor is prepared and poured. Applicants respectfully submit that if the Examiner is relying on inherency as the basis of teaching a recited element then the rejection must fail.

The operation of inherency in matters concerning anticipation was aptly explained in *Continental Can Co., U.S.A. v. Monsanto Co.*, 948 F.2d 1264, (Fed. Cir. 1991), rehearing denied 1991 U.S. App. LEXIS 29979 (Fed. Cir. Dec. 26, 1991), which addressed the matter in the context of a summary judgment decision. “To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Id.* at 1268. Applicants respectfully urge that in maintaining the rejection under 35 USC §102, the Examiner has erred in setting forth rejections based upon an assertion that Paoli “inherently” includes elements not expressly taught - without providing any support for such assertions. Appellants maintain that to rely on the assertion that a reference “inherently” describes an element, the Examiner has the burden of setting forth in the rejection, a basis for such a conclusion; and that the case law clearly establishes that any evidence relied upon to support the assertion of inherency must be set forth, along with an indication of the necessity of the allegedly inherent, but missing, element(s). Absent such support claim 1 cannot be anticipated by Paoli and the rejection is respectfully traversed.

The rejection also indicates that the step of integrating aggregate into the upper surface is taught at col. 2, lines 65-70. Applicants submit that at the point described, Paoli is teaching an alternative, poured-in-place terrazzo, where a concrete topping having aggregate mixed therein, and splatters, are applied on top of a base – not a monolithic pour. Applicants also note that Paoli fails to teach the amended limitation of claim 1, which requires “disbursing a quantity of decorative aggregate over only the surface of the semi-stiff concrete.” Nor does Paoli appear to teach the recited steps of grinding the

partially cured surface, or permitting the concrete to fully cure followed by polishing as recited in claim 1. In view of the failure to teach all of the limitations recited in amended claim 1, Paoli cannot anticipate the amended claim. For the reasons set forth above relative to claim 1, the rejection as applied to claims 3, 4 and 7 is also traversed.

**35 U.S.C. 103(a)**

Claims 6 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw. Shaw is urged as teaching the limitations of claims 6 and 13. The limitations of these two claims differ and Applicants will address a traversal of both rejections independently.

As to claim 6, Shaw is urged as defining a semi-stiff state at col. 4, lines 14-16, where the aggregate is described as not initially depressing below the top surface, and later at lines 26-30, where the state of the **particulate AND concrete** “has sufficiently set such that a finger impression ... is made upon manually pressing with fingertips...” Not only do the cited portions of Shaw fail to teach the specific limitations of claim 6, but they also are not directed to the same point in the process – claim 6 characterizing the state of the concrete before the upper surface is poured and then followed by disbursing the aggregate over the surface. Accordingly, Shaw does not teach the limitations of claim 6.

Having acknowledged that Shaw fails to teach the limitations of claim 6, the Examiner nonetheless maintains that the limitations of claim 6 would be obvious in light of Shaw’s teachings. As the basis for the conclusion of obviousness, the Examiner urges, without citing any particular teaching for support, that because the methods (both as presently claimed and taught by Shaw) are “defined in such general terms” (Office Action, p. 6) claim 6 is unpatentable. Applicants respectfully urge that the limitations of claim 6 are not found in Shaw, and that as a result the Examiner has not established a *prima facie* rejection to which Applicants can or must respond. Accordingly the rejection is respectfully traversed. In the event the rejection is maintained, Applicants request that a subsequent communication set forth in detail, those teachings relied upon or employed by the Examiner as the basis for the conclusion that the method claimed is “effectively undifferentiated.”

Turning to claim 13, the rejection indicates that although Shaw does not teach the recited scoring with a diamond saw to facilitate uniform stress releasing fracture, that

such a step would have been *prima facie* obvious. The rejection urges, without support, that such a step would provide expansion or contraction joints. Applicants respectfully note that the limitation of scoring with the diamond saw “facilitates uniform stress releasing fracture” and is not preventing the concrete from cracking. Accordingly, Applicants further urge that the Examiner’s basis for the rejection is unsupported by the teachings of Shaw. Thus, in spite of the Examiner’s assertion, *prima facie* obviousness has not been established as no citation of the claimed elements has been set forth and no proper basis for the conclusion of obviousness has been set out in the rejection. Hence, Applicants respectfully traverse the rejection of claim 13 as well. In the event the rejection is maintained, Applicants request that support for the conclusion of obviousness be specifically identified in a subsequent communication.

Claims 8-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Jones. Applicants respectfully traverse the rejection and incorporate herein the arguments and distinctions noted between the independent claims and the teachings of Shaw.

Notably, the Examiner also suggested, in setting for the rejection of claims 8-12, that the teachings of Jones support the “inherent argument in the 102(b) rejection above.” Applicants respectfully contend that in the event the Examiner is relying on teachings of Jones to support an assertion of inherency in a prior rejection that such a teaching must be expressly stated in the rejection so that Applicants can respond thereto. Otherwise, it is unclear to which rejection the Examiner is referring.

Turning to the rejection, the Examiner states that Shaw does not explicitly state that the hardening the surface is the purpose for or result of applying a sealer. Jones, however, is urged as teaching the application of a silicate-based hardening compound. The basis for the combination is alleged by the Examiner to be the “complimentary nature of the two methods” (Office Action, p. 7). However, Applicants note, as set forth above, that Shaw is directed to providing an exposed particulate surface and teaches treatment of the surface, by spray or brush (col. 5, lines 7-8), to seal or provide a protective barrier (col. 4 line 66 – col. 5, line 24). On the other hand, Jones teaches a general process of polishing/hardening at col. 7, line 25 – col. 8, lines 24, where a hardening/densifying compound is applied to cured concrete, and the surface is then polished using a diluted polishing compound. Applicants respectfully urge that the methods (Shaw teaching

sealing of an exposed particulate and Jones teaching hardening/densifying and polishing of a flat surface) are not only distinct, but are also not complementary. The rejection fails to set forth the manner in which the teachings would be combined. Accordingly, the combination is urged to be improper and that *prima facie* obviousness has not been established.

Considering, *in arguendo*, the combination of Shaw and Jones, at most such a combination teaches the substitution of the Jones hardening/densifying compound for the Shaw sealer. The arguable combination does not teach, in order, various of the steps set forth in the amended claims, including partially curing the concrete, followed by grinding the upper surface of the partially cured concrete, including partially removing some integrated aggregate material at least until the aggregate is exposed uniformly over the top of the concrete, and then fully curing the concrete with the integrated aggregate before polishing the upper surface with the integrated aggregate to provide a generally planar and smooth surface, and applying a hardening compound after polishing as required by claim 8 and claims dependent therefrom.

Relative to the rejection of claims 11 and 12, Applicants respectfully incorporate the arguments above and further note that the limitations of claim 11 are directed to further characterize a grinding operation performed on partially cured concrete. Applicants urge that not only is such an operation not taught by Shaw or Jones, but that as a result of the unique operation of grinding the partially cured concrete, the specific materials and steps employed would not have been obvious as such techniques are known relative to operations on cured concrete as disclosed by Jones. The rejection further urges that one of skill in the art would have determined the claimed steps and materials. Applicants respectfully request that the Examiner provide a basis for such a conclusion and set forth the reference relied upon as teaching the limitations of claims 11 and 12 as applied in the process of claim 1 from which they depend. Otherwise, Applicants maintain that *prima facie* obviousness has not been established and that claims 11 and 12 are patentably distinguishable over the arguable combination of Shaw in view of Jones.


### **Conclusion**

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are

required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicants' attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. C. Basch', is written over a horizontal line. To the right of the signature, the date '8/18/06' is handwritten.

Duane C. Basch, Attorney for Applicants  
Registration No. 34,545  
Basch & Nickerson LLP  
1777 Penfield Road  
Penfield, New York 14526  
(585) 899-3970

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